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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,134	01/27/2004	George N. Serbedzija	018852-000610US	1970
20350	7590	05/04/2007	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP			BERTOGLIO, VALARIE E	
TWO EMBARCADERO CENTER			ART UNIT	PAPER NUMBER
EIGHTH FLOOR			1632	
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			05/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/766,134	SERBEDZIJA ET AL.
	Examiner	Art Unit
	Valarie Bertoglio	1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 14 February 2007.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 67-80 and 82-84 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 67-80 and 82-84 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 01/27/2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

### **DETAILED ACTION**

Applicant's amendment filed 02/14/2007, has been entered. Claims 1-66 and 81 have been cancelled. Claims 67, and 72-77 have been amended. Claims 67-80 and 82-84 are pending and under consideration in the instant office action.

#### ***Priority***

The amendment to the specification updating the status of the priority document is noted.

#### ***Specification***

The amendments to the specification amending typographical errors are noted.

#### ***Claim Rejections - 35 USC § 112-1<sup>st</sup> paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

#### ***Enablement***

Claims 67-76,78-80, and 82-83 remain rejected and claims 77 and 84 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of analyzing a sample comprising cells for the presence of a cancer cell comprising obtaining a sample from a patient containing a cell or a population of cells, introducing the cell or the population of cells into an embryo of an oviparous teleost fish species that has not yet developed an immune system that would subject the cancer cells to immune rejection, and detecting a property of the cell or the population of cells to indicate whether the cell or the population of cells comprises a cancer cell does not reasonably provide enablement

for carrying out the claimed method in any viviparous teleost fish species. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The rejection is maintained for reasons of record set forth at pages 3-6 of the office action dated 09/26/2006 and reiterated below.

Claims 77 and 84 have been added to the scope rejection as the full lack of enablement rejection has been withdrawn as set forth below. It is noted, however, that this is not a new grounds of rejection.

Claims are directed to methods of cellular analysis comprising introducing one or more cells into a fish embryo and analyzing a property of the transplanted cells to determine the presence of a cancerous cell. Limiting embodiments to the parent claim include the source of the cells, the species of fish embryo used, the placement within the embryo of the heterologous cells, and various analysis steps including determining proliferation, death, metastasis, cellular uptake of dyes indicating cell to be cancerous and expression of proteins indicative of cancerous cells.

Applicant's amendment and remarks regarding the breadth of fish species used in the claimed method are not persuasive in overcoming the aspect of the rejection relating to use of viviparous species. The claims have been amended to read "teleost" fishes and Applicant argues that teleost fishes are all oviparous and thus, the claims, by reciting "teleost" no longer encompass viviparous species. However, it is disagreed that all teleosts are oviparous and the claims continue to encompass viviparous teleosts, which are not enabled for reasons of record. For example, Koya *et al.*, use a viviparous teleost species of rockfish, *Sebastes schlegeli* [Zoological Science, 21:565-73, 2004].

The aspect of the rejection pertaining to detection of a pathogen is withdrawn in light of Applicant's arguments (see pages 9-11 of Applicant's Remarks dated 02/14/2007).

Likewise, the rejection of claims 77 and 84 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement is withdrawn as it relates to the claims not being enabled for screening pathogenicity. However, the above set forth scope of enablement now applies.

*Written Description*

The rejection of claim 81 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn in light of Applicant's cancellation of the claim.

*Claim Rejections - 35 USC § 112-2<sup>nd</sup> paragraph*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of claims 73 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in light of Applicant's amendment to the claim.

*Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or

claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 83 remains rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,33,40 and 16 of U.S. Patent No. 6,761,876 as set forth at page 8 of the office action dated 09/26/2006.

Applicant asserts that a terminal disclaimer will be filed upon indication of allowable subject matter. As such, the rejection is maintained.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Valarie Bertoglio whose telephone number is (571) 272-0725. The examiner can normally be reached on Mon-Thurs 5:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras can be reached on (571) 272-4517. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications and (571) 273-8300 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-0532.



Valarie Bertoglio  
Primary Examiner  
Art Unit 1632